



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,915	10/30/2003	Nilesh Pathak	03581.008900.	5645
5514 7590 05/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER LEE, WILSON	
			ART UNIT 2163	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,915	PATHAK ET AL.	
	Examiner	Art Unit	
	Wilson Lee	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-55 and 57-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-55 and 57-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections – 35 U.S.C. 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41-55, 57-81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding Claims 41, 77, “current need for maintenance and a potential future need for maintenance” are not taught in the specification to enable to one skilled in the art to make or use the invention.

Claims 42-55, 57-76, 77-81 are vague by virtue of their dependency on claims 41, 77.

Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Art Unit: 2163

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 41-55, 57-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Carling et al. (US 2003/0128991).

Regarding Claim 41, Carling discloses a method of interfacing a plurality of electronic devices that from time to time require maintenance, comprising:

- transmitting maintenance status information relating to at least one of a current need for maintenance and a potential future need for maintenance from an electronic device (printer 5) to a central server (server 3 at the centralized site), by at least one of direct communication and communication via at least one intermediary device (See Figure 1a, abstract and paragraphs 0008-0013, 0025-0030, 0038); and
- in response to the maintenance status information transmitted from the electronic device, transmitting a message to an entity (See paragraph 0027) relevant to the electronic device, that enables the entity to obtain from the central server the maintenance status information about the electronic device (See paragraphs 0008-0013, 0025, 0028 and abstract),
- wherein the transmission of the maintenance status information is initiated by at least one of the electronic device and the at least one intermediary device (paragraphs 0038, 0039, 0044, 0062, 0065),

- said message comprises a hypertext link (paragraph 0057), and
- the central server comprises a web server which is arranged to respond to the hypertext link being activated, to provide the maintenance status information about the electronic device (Abstract, paragraphs 0008-0013, 0025-0030, 0038, 0057).

Regarding Claim 42, Carling discloses that the central server comprises a means for analyzing the received maintenance status information (Abstract, paragraphs 0008-0013, 0025, 0027, Figure 1a).

Regarding Claim 43, Carling discloses that the analyzing means determines, depending on the received maintenance status information if the message is to be sent to a relevant entity or not. (paragraphs 0027-0030, 0038, 44-46, 50-54).

Regarding Claim 44, Carling discloses that the analyzing means determines, depending on the received maintenance status information when the message is to be sent to a relevant entity. (paragraphs 0027-0030, 0038, 44-46, 50-54).

Regarding Claim 45, Carling discloses that the analyzing means determines, depending on the received maintenance status information to which relevant entity the message is to be sent. (paragraphs 0027-0030, 0038, 44-46, 50-54).

Regarding Claim 46, Carling discloses that the analyzing means determines according to condition data if the message is to be sent to a relevant entity or not. (paragraphs 0027-0030, 0038, 44-46, 50-54).

Regarding Claim 47, Carling discloses that the analyzing means generates the message (paragraphs 0008-0013, 0025, figs. 3, 4).

Regarding Claim 48, Carling discloses that the central server has access to a database for storing data, wherein maintenance status information received by the central server is stored in the database. (Abstract, paragraphs 0025-0027, 0051, 0059, 0060, fig. 1a).

Regarding Claim 49, Carling discloses that the analyzing means has access to data stored in the database. (Abstract, paragraphs 0025-0027, 0051, 0059, 0060, fig. 1a).

Regarding Claim 50, Carling discloses that the maintenance status information, sent to the central server, includes a first type of information indicating the need of maintenance of at least one of the electronic devices and a second type of information about the usage of at least one of the electronic devices (abstract, paragraphs 0008-0013 and figs).

Regarding Claim 51, Carling discloses that maintenance status information, sent to the central server, includes information for the identification of the electronic devices (paragraphs 0038, 0039 and 0059).

Regarding Claim 52 Carling discloses that the message contains at least part of the maintenance status information about the electronic device (See paragraphs 0008-0013, 0025).

Regarding Claim 53, Carling discloses that the maintenance status information provided by the central server in the message to the entity is supplemented with additional relevant data from a database accessible to the central server. (See paragraphs 0008-0013, 0025-0030, 0038, 44-46, 50-54).

Regarding Claim 54, Carling discloses that the entity has access to at least one service management computer system containing data about the electronic devices about which the entity is sent said message. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 55, Carling discloses that at least part of the maintenance, status information supplied by the central server is supplemented with additional relevant data from a database accessible to the central server. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 57, Carling discloses that data provided by the central server to an entity, or the form of that data, depends on the entity. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 58, Carling discloses transmitting data from said entity to the central server. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 59, Carling discloses the data transmitted includes data the electronic devices serviced by said entity. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 60, Carling discloses transmitting data from the central server to said entity. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 61, Carling discloses that the data transmitted includes data about the usage of an electronic device. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 62, Carling discloses that the central sever is arranged to receive data from a service management computer system. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 63, Carling discloses that the data received from the service management computer system includes data about the electronic devices serviced by said service management system. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 64, Carling discloses that the central server is arranged to transmit data to a service management computer system. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 65, Carling discloses that the data transferred includes data about the usage of an electronic device. (See paragraphs 0008-0013, 0025-0030, 0038, 0044-46, 50-60, figs. 1a, 8-10).

Regarding Claim 66, Carling discloses that data relating to the usage of an electronic device is transferred directly to at least one service management computer system, without requiring operator intervention. (See paragraphs 0008-0013, 0025-0030, 0033, 035, 0053-0059, 0062, fig. 1a)

Regarding Claim 67, Carling discloses that said data about the usage of an electronic device is sent to said service management computer system inherently in batches (fig. 1a, 10, paragraphs 0008-0013, 0025-0030, 0033, 035, 0053-0059, 0062).

Regarding Claim 68, Carling discloses that the data about the usage of an electronic device is sent to said service management computer system once a threshold condition has been met (condition that pass firewall).

Regarding Claim 69, Carling discloses that the transmitting of the maintenance status information from the electronic device devices to the central server is by email that is addressed differently for maintenance status information from different electronic devices (all firewalls or security system including Carling can perform the above) (See paragraph 0064).

Regarding Claim 70, Carling discloses that the transmitting of the maintenance status information from the electronic device devices to the central server is by email that is addressed differently for indications that the device requires attention and for information regarding the usage of the device (all firewalls or security system including Carling can perform the above) (See paragraph 0064).

Regarding Claim 71, Carling discloses that maintenance_status information for a set of devices is relayed by a common unit (a piece of cable) to the central server (See fig. 1a, paragraphs 0008-0013, 0025-0030).

Regarding Claim 72, Carling discloses that the central server is arranged to provide a report of which electronic devices provide maintenance status information to the common unit (a piece of cable) (Fig. 1a, paragraphs 0008-0013, 0025-0030).

Regarding Claim 73, Carling discloses that the central server is arranged to provide a single report of maintenance status information about a plurality of the electronic devices that provide maintenance status information to the common unit (paragraphs 0008-0013, 0025-0030).

Regarding Claim 74, Carling discloses that the central server is arranged to provide a history of maintenance status information about an electronic device (paragraphs 0008-0013, 0028, 0031, 0040, 0050 and fig. 6).

Regarding Claim 75, Carling discloses that the central server is arranged to provide an analysis of faults or usage over a plurality electronic devices. (paragraphs 0008-0013, 0028, 0031, 0040, 0050 and fig. 6).

Regarding Claim 76, Carling discloses that the said entity is given access to maintenance status information relating to one or more electronic device to which it is not relevant (paragraphs 0027-0030, 0038, 44-46, 50-54).

Regarding Claim 77, Carling discloses a method of interfacing a plurality of electronic devices that from time to time require maintenance comprising:

- transmitting maintenance status information relating to at least one of a current need for maintenance and a potential future need for maintenance from an electronic device (printer 5) to a central server (server 3, at the centralized site), by at least one of direct communication and communication via at least one intermediary device (See Figure 1a, abstract and paragraph 0008-0013, 0025-0030, 0038); and

- in response to the maintenance status information transmitted from the electronic device, transmitting a message containing information based on the maintenance status information, to an entity (See paragraph 0027) relevant to the electronic device (See paragraphs 0008-0013, 0025-0030, 0038 and abstract);
- said message comprising a hypertext link (paragraph 0057);
- providing a web server that has access to at least the maintenance status information about the electronic device, said web server responding to the activation of the hypertext link to provide the maintenance status information (Abstract, paragraphs 0027, 0057).

Regarding Claim 78, Carling discloses that one of the central server and the web server comprises a means for analyzing the received maintenance status information (fig. 1 and paragraphs 0008-0013, 0025, 0027).

Regarding Claim 79, Carling discloses that one of the central server and the web server has access to a database for storing data, wherein maintenance status information received by the server is stored in the database (Abstract, paragraphs 0025-0027, 0051, 0059, 0060, fig. 1a).

Regarding Claim 80, Carling discloses that the analyzing means has access to data stored in the database (Abstract, paragraphs 0008-0013, 0025-0027, 0051, 0059, 0060, fig. 1a).

Regarding Claim 81, Carling discloses that the transmission of maintenance status information is initiated by said electronic device and the least one intermediary device devices (paragraphs 0008-0013, 0038, 0039, 0044, 0062, 0065).

Response to Arguments

Applicant's arguments with respect to claims 41-55, 57-81 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Wilson Lee', is written over a horizontal line.

Wilson Lee
Primary Examiner
U.S. Patent & Trademark Office

5/13/07